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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,554	09/05/2003	Martin Sproat	920476-94756	8188
23644 7590 04/29/2008 BARNES & THORNBURG LLP P.O. BOX 2786 CHICAGO, IL 60690-2786				
EXAMINER NGUYEN, STEVEN H D				
ART UNIT 2619		PAPER NUMBER		
NOTIFICATION DATE 04/29/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent-ch@btlaw.com

Office Action Summary

Application No.

10/656,554

Applicant(s)

SPROAT ET AL.

Examiner

STEVEN H.D NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-62 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 17-62 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/CDC)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 61-62 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not disclose a program, software etc... on a machine readable medium for carrying out the method.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 61-62 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed limitation does not include a computer readable medium storing a software when execute by a processor. Therefore, the claim is just a carrier wave or signal on a medium.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined

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application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 17-62 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6643297. Although the conflicting claims are not identical, they are not patentably distinct from each other because the applicant's claims 17-62 merely broaden the scope of patented claims 1-12 by not claim some elements such as ATM switch, conversion between TDM and ATM. The applicant's claims are nearly identical in every other respect to the patented claims. Therefore, the application's claims are simply broader versions of the patented claims. It is the examiner's position that broadening the patented claims by not claiming some of claim elements of the patented claims would have been obvious to one of ordinary skill in the art in view of the patented claims. It is important to note that the instant application is a continuation in part of the application, which yielded the patent (US Pat 6643297) used herein as the basis for the obviousness type of double patenting rejection. The applicant is attempting to broaden the parent application's claims by eliminating some of the claim elements in the continuation at issue here. If allowed, the application at bar would unjustly

extend applicant patent protection beyond the statutory period, at the same time, granting broader protection to the application.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 17-62 rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson (USP 6262992) in view of Ramakrishnan (US 2003/0012196).

As claims 17-19 and 23, Nelson discloses a telecommunications system comprising a packet mode switch fabric (Fig 4, Ref 114) comprises a network having a plurality of interconnected switching devices; and an access network comprising a plurality of circuits and a plurality of network devices connected to said switching devices (Fig 5); a source device (Fig 4, Ref 106) and a destination device (Fig 4, Ref 120), said source device being connected to said destination device by a channel through the switch fabric and traffic from said source device to said destination device being carried as a stream of packets on said through channel (Col. 3, lines 12-63) and a call activity comprising tone (Fig 2, Ref 230). However, Nelson fails to disclose a switch means for replicating said stream of packets and communicating said replicated packet stream to a network device over a channel connecting the through channel to the network device. In the same field of endeavor, Ramakrishnan discloses a switch means (Fig 4, Ref 210) for replicating said stream of packets and communicating said replicated packet stream includes only performing replication of the stream of packets in association with a call activity (Page 2, Sec

17) to a network device over a channel connecting the through channel to the network device (Fig 3, Ref 230) .

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method and system comprising switch means for replicating said stream of packets and communicating said replicated packet stream to a network device over a channel connecting the through channel to the network device as disclosed by Ramakrishnan. The motivation would have been to reduce a cost of system.

As claims 20, 51 and 60, Ramakrishnan discloses traffic is carried bi-directionally between the source device and the destination device by first and second packet streams on respective first and second channels and said means for replicating replicates each of said first and second streams and communicates the replicated streams to the network device on respective connecting channels (Figs 4-6).

As claim 21, 57, Ramakrishnan discloses said switch means for replicating the stream of packets comprises a switch (Fig 4, Ref 210).

As claim 22, Ramakrishnan discloses the switch fabric comprises a packet mode switch (Fig 4, Ref 210).

As claims 24 and 52, Nelson discloses said through channel comprises a packet stream part of an end to end circuit across the network (Fig 5), said circuit extending through a time division multiplexed (TDM) access channel on a source device side of the network (fig 5, Ref 502), through said packet stream channel (Fig 5, Ref 104) and through a TDM access channel on a destination device side of the network (Fig 5, Ref 506), said switching devices including

adaptation devices for converting traffic between a TDM mode and a packet stream mode (Fig 5, Ref 104).

As claims 25, 39, 47, Ramakrishnan discloses said end to end circuit between said source device and said destination device comprises first and second channels carrying respective first and second packet streams and said means for replicating the packet stream replicates each of said first and second packet streams and directs each of them on respective connecting channels to the network device (Figs 4-6).

As claims 26, 46, Ramakrishnan discloses said means for replicating the stream of packets broadcasts said replicated stream of packets to a plurality of network devices on respective connecting channels (Page 1, Sec 10).

As claims 27, 36, 44, 53, 59, Ramakrishnan discloses network device comprises a voice processing device (Fig 4, Ref 230 is used to monitor voice is inherently disclosed a voice processing device).

As claims 28, 38, Ramakrishnan discloses said network device comprises an intelligent peripheral device (Fig 4, Ref 230).

As claim 29, Ramakrishnan discloses said network device comprises a network service provider device (Fig 4, Ref 230).

As claim 30, Nelson discloses through channel comprises a circuit switched connection through the switch fabric between the source device and the destination device (Fig 5).

As claims 31, 37, 45, Ramakrishnan discloses the network device is co-located with the replicating means (Fig 3).

As claims 32-35, Nelson discloses telecommunications system comprising a circuit switched switching network (Fig 5, Ref 502) ; a source device and a destination device, said source device being connected to said destination device by a circuit switched connection through the switching network (Fig 5, ref 504, 508), said circuit switched connection having a packet mode portion for carrying traffic from the source device to the destination device as a packet stream having a tone (Fig 5, Ref 104-510-104). However, Nelson fails to disclose switch element for replicating said stream of packets at said packet mode portion of the circuit switched connection and communicating said replicated packet stream to another circuit. In the same field of endeavor, Ramakrishnan discloses switch element (Fig 4, 210) for replicating said stream of packets includes only performing replication of the stream of packets in association with a call activity at said packet mode portion of the circuit switched connection and communicating said replicated packet stream (Page 2, Sec 17) to another circuit (Fig 3, Ref 230).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method and system comprising switch element for replicating said stream of packets at said packet mode portion of the circuit switched connection and communicating said replicated packet stream to another circuit as disclosed by Ramakrishnan. The motivation would have been to reduce a cost of system.

As claims 40-43, 48-50, 54-56, 58 and 61-62, Nelson discloses a communications network switch capable of establishing a circuit switched connection for the transport of packets comprises a plurality of through channels capable of carrying packet streams through the switch (Fig 5); a plurality of adaptation devices for adapting incoming traffic flows to respective packet streams including tone and supplying said streams to respective through channels (Fig 5, Ref

104). However, Nelson fails to disclose means for replicating a packet stream on a selected through channel and communicating the replicated packet stream to another channel. In the same field of endeavor, Ramakrishnan discloses means for replicating (Fig 4, Ref 210) a packet stream in association with an activity of a call on a selected through channel and communicating the replicated packet stream (Page 2, sec 17) to another channel the another channel comprises a packet mode channel which connects the through channel whose packet stream is being replicated to a network device (Fig 3, Ref 230).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method and system comprising means for replicating a packet stream on a selected through channel and communicating the replicated packet stream to another channel as disclosed by Ramakrishnan. The motivation would have been to reduce a cost of system.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN H.D NGUYEN whose telephone number is (571)272-3159. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jayanti Patel can be reached on (571) 272-2988. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steven H.D Nguyen/
Primary Examiner, Art Unit 2619